

Remarks

Applicant respectfully submits the following remarks in response to the December 22, 2006 Office Action Summary ("Office Action").

I. Claim Rejections – 35 U.S.C. § 102(e)

Applicant respectfully traverses the Examiner's rejection of claims 1-9, 22-30, 32-41 and 49-51 under 35 U.S.C. § 102(e) as being unpatentable over Cannon (6,652,378). Claims 11-20 are cancelled. There is no claim 52.

Applicant understands the Examiner's rejection to be based on his conclusion that the "secondary" games of Cannon can function as the "bonus indicator" disclosed and claimed in the present invention because a secondary game of Cannon can indicate whether a player is entitled to a bonus feature, (*see* Office Action at 4). Therefore, according to the Examiner, Cannon reads on the claim limitations of the present invention. (*Id.*)

Without conceding the correctness of these conclusions,¹ applicant has nonetheless further amended her claims to include additional, positive limitations to further distinguish the bonus indicator of the present invention from Cannon's "secondary" game. Specifically, the claims to the present invention now include limitations that:

¹ Applicant respectfully disagrees with the Examiner's determination that the secondary game of Cannon anticipates the bonus indicator of the present invention for the reasons set forth in applicant's Response to Final Office Action and Request for Continuing Examination filed October 3, 2006. Applicant will not focus on previously raised distinctions in this response, however, and will instead focus on additional distinctions that independently render the present invention patentable over Cannon.

- the bonus indicator is enabled by the making of a wager in the primary game; and
- the bonus feature awarded by the bonus indicator is a bonus feature of the primary game.

These limitations are fully supported by the current specification at page 5, lines 2-4 (discussing a bonus indicator activated by a minimum bet in the primary game) and page 8, lines 10-23 (bonus indicator is activated by bet in primary game to which it relates). Because the secondary game of Cannon is neither enabled by the wager in the primary game nor a bonus feature of the primary game, Cannon is not anticipatory; these limitations are not taught by Cannon.

Cannon discloses a gaming apparatus and method having a plurality of different games which operate simultaneously. In the Examiner's opinion, one or more of these games may act as a bonus indicator. (Office Action Summary at 2). This opinion is based upon the Examiner's finding that a bonus may be indicated by one or more of the games in Cannon and that "[a]ny of the plurality of games played may be designated as a 'primary' or 'bonus' game, as there is nothing inherent in a primary or bonus game which is not disclosed by Cannon." (*Id.*)

Initially, a distinction should be made between a bonus indicator and a bonus game or feature. As described in the present invention, a bonus indicator indicates whether or not a player is entitled to a bonus feature or game. (*See e.g.*, Specification at pg. 5, lines 8-16; Claim 1). The bonus feature or game, in turn, is a bonus round of some sort, enabled by a randomly generated outcome of the bonus indicator. (*See* Specification at pg. 8, lines 5-9).

Accepting for the sake of argument that one or more of the plurality of games in Cannon may act as a bonus indicator, certain aspects of the Cannon games bear highlighting. Initially, and as argued previously, the Cannon secondary games are games, whether or not they also function as bonus indicators. As games, the secondary games of Cannon are enabled by assignment of a specific wager to the game. (*See Cannon*, Col. 21, line 65 to Col. 22, line 67). If a winning result is obtained on the game, the player is awarded credits based upon the winning result and the amount wagered in the game. (*See Cannon*, Col. 23, line 59 to Col. 24, line 4).

The independent claims of the present invention have each been amended to include a limitation not found in Cannon. Independent claims 1, 49 and 51 are amended to state that the bonus indicator is "enabled by credit wagered in said primary game." (Currently amended claims 1, 49 and 51 hereto). Similarly, independent claims 22 and 32 are amended to provide that the separate bonus indicator is initiated automatically "when credit is wagered in said primary game." (Currently amended claims 22 and 32 hereto).

With these amendments it is made clear that the separate, independently operating bonus indicator of the present invention is enabled by credit played in the primary game. This limitation is not found in Cannon, where the secondary game is enabled by credit played in the secondary game. The applicant therefore respectfully submits that the present invention includes a limitation absent from Cannon and any of the other cited prior art, and is therefore patentable.

The applicant notes that in one embodiment of Cannon the specification discloses providing a player with a "complimentary game" at some predetermined high level of wagering.

(Cannon, Col. 26, lines 21-34). While in this embodiment, the secondary bonus game² is not enabled by credit played in the secondary game, because it is complimentary, it is also not enabled by credit played in the primary game as in the present invention. "The complimentary game may be caused to play automatically in response to a player's initiation of play in one or more other games" (Col. 26, lines 35-38), but this refers to causing play, e.g., initiating the spinning of reels, whereas enabling play refers to a pre-initiation of spinning step wherein the game determines that the reels will be allowed to spin. The complimentary game is not enabled by credit played in the primary game. Instead, it is enabled "[a]t some predetermined high level of wagering, which may consider the number of games played per time and/or number of dollars waged per time period" (Col. 26, lines 21-24) or upon achieving "a particular outcome or level of winning" (Col. 24, lines 15-25). These enablement events do not anticipate enablement by credit played in the primary game as in the present invention.

In addition to the secondary game of Cannon not being enabled by credit played in the separate, independently operating primary game, the bonus indicator of the present invention is also distinguishable in that it indicates a bonus event or feature for the primary game as opposed to the secondary game. The amended independent claims of the present invention each address "a primary game featuring [or that includes] a bonus feature" (amended claims 1, 22, 32 and 51) or "a bonus feature for said primary game" (amended claim 49). The bonus indicator of the present invention determines whether or not the bonus feature of the primary game will be enabled. In Cannon, a primary and secondary game may be played simultaneously and a

² In this embodiment, following without conceding to the examiner's reasoning, the complimentary game is a bonus game as well as a secondary game/bonus indicator for a potential additional bonus game.

particular outcome in one or more of the games may activate one or more bonus games.

(Cannon Col. 24, lines 18-26). If the secondary game indicates that a bonus feature has been won, however, the bonus feature is a feature of the secondary game, just as an indication in the primary game that a bonus feature has been won will lead to a bonus feature of the primary game. Cannon, therefore, does not anticipate the aspect of the present invention where the bonus indicator (assuming this is the secondary game in Cannon) indicates whether or not the player is entitled to the bonus feature of the primary game.

In sum, the bonus indicator of the present invention includes the following limitations:

- separate location from primary game;
- substantially simultaneous operation with primary game;
- independent of outcome of primary game;
- non-identical to primary game;
- of approximate same duration as primary game;
- enabled by the wager made in the primary game;
- indicates whether player goes onto a bonus round of said primary game.

Even if the secondary game of Cannon anticipates the first five aspects of the present invention, the last two render the present invention novel and non-obvious for the reasons set forth above.

Applicant has amended each of the remaining independent claims of the application, and the amendments are therefore applicable to all the dependent claims as well. An anticipatory

reference under § 102 must contain each and every limitation of the claims it anticipates.

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379 (Fed. Cir. 1986). For the reasons set forth above, the separate, distinct, independent bonus indicator of amended independent claims 1, 22, 32, 49 and 51 of this invention, enabled by credit played in the primary game and indicating whether or not player is entitled to a bonus feature of the primary game, and all the other claims which depend therefrom, are not taught or disclosed by Cannon. The Applicant respectfully requests that the Examiner withdraw his rejections.

Respectfully submitted,



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